

Appln. No.: 10/672,654
Filed: September 26, 2003
Reply to Office action mailed January 21, 2010
Response filed April 21, 2010

REMARKS

Claims 1-7, 9-19, 21-31, and 33-40 are pending in the Application and all have been rejected in the Office action mailed January 21, 2010. No claims are amended by this response. Claims 1, 14, and 25 are independent claims from which claims 2-7 and 9-13, claims 15-19 and 21-24, and claims 26-31 and 33-40 depend, respectively. Applicants respectfully request reconsideration of pending claims 1-7, 9-19, 21-31, and 33-40, in view of the remarks that follow.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

In addition, as noted above, no claims are amended by this response. Thus, this response does not raise new issues that would necessitate a new search.

Rejections Under 35 U.S.C. 103

Claims 1-7, 9-19, 21-31, and 33-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis, *et al.* (US 6,774,926, hereinafter "Ellis"), in view of Schoen, *et al.* (US 7,321,969, hereinafter "Schoen"), and further in view of Parker, *et al.* (US 20040125789, hereinafter "Parker"). The Applicants respectfully traverse the rejections.

Applicants first review requirements for establishing a rejection under 35 U.S.C. §103. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, M.P.E.P. §2143.03 states, in part:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations **must** be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim **must** be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

(emphasis added)

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, **all** the words in a claim **must** be considered during the examination process.

Further, in *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness with respect to any of the pending claims.

With regard to independent claim 1, Applicants respectfully submit that claim 1 recites, in part, “[a] system supporting the communication and consumption of media using a common user interface, the system comprising: ... software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content, the software also enabling closed and secure communication of the one or more media channels to members of a

user group, in a peer to peer manner, from the first home to the second home.” Applicants respectfully note that claims 14 and 25 have been amended to recite similar features. Applicants respectfully submit that the cited art does not teach or suggest at least these elements of claim 1.

The Office rejects this aspect of claim 1 at page 5 of the instant Office action stating, in part:

Regarding to claim 1: Fig.1 of Ellis illustrates a system [30] supporting the communication and consumption of media using a common user interface (i.e. a display screen 130 that may be displayed by an interactive television program guide is shown in FIG. 9), **the system comprising: ... software resident in a first memory at the first home** (i.e. The interactive television program guide may be implemented using software that runs locally on user television equipment 36 using a set-top box) **and a second memory at the second home** (i.e. An interactive television program guide may be implemented using software that runs locally on user equipment 34 using computer [78]) **(Ellis, col. 8 lines 51-61)**, Fig. 11 of Ellis shows the program guide screen [156] as **the software enabling a user at the first home** (i.e. user interface of Set-top box) **to construct, at the first home** (i.e. user equipment [36]), **the one or more media channels from user selected** (i.e. if user selects option [166] on Menu screen [156] may contain information on the top 100 personal television channels including Star rating and Ratings for top 100 personal TV channels.) **and scheduled media content** (i.e. user select option [162] may provide the user with an opportunity to view program schedule information for personal television channel programming.) , **(Ellis, col. 10 line 34-col. 11 line 25)**, ...

(emphasis in original)

Initially, Applicants respectfully note that the Office identifies only Ellis and only at col. 8, lines 51-61 and col. 10, line 34 to col. 11, line 25 as teaching this aspect of Applicants’ claim 1. Applicants respectfully submit that the cited portions of Ellis do not

teach what is asserted. Applicants begin by addressing the portion of Ellis at col. 8, lines 51-61, which are shown below in context and underlined:

Another approach involves using an interactive television program guide to access the schedule information. An interactive television program guide may be implemented using software that runs locally on user equipment 34 or may be implemented using a client-server architecture or distributed approach in which a program guide server process running on a server or servers is accessed by a client process running on client equipment. The interactive television program guide may be implemented on user television equipment 36. For example, the program guide may be implemented using a set-top box. The program guide may also be implemented on user computer equipment 38. For example, a web browser may be used to access an on-line program guide web site. Cellular telephone 42 may also be used to support a program guide. Program listings and (if desired) selectable options may be displayed on display 100 (FIG. 6). The user of cellular telephone 42 may interact with the displayed items using buttons on the telephone.

In the cited portion of Ellis shown above, Ellis discloses an “interactive television program guide” used to access “schedule information.” The “interactive television program guide” may be software that runs locally on user equipment such as a user television, set-top box, or computer, or may run on a server accessed by client equipment. Further, a cellular telephone may be used to support the program guide. The cited portion of Ellis at col. 8, lines 51-61, shown above, does not, however, teach, suggest, or disclose a user “constructing” anything, let alone constructing one or more “media channels.” This portion of Ellis also fails to disclose anything with regard to user selection of “media content, and fails to disclose user scheduling of “media content,” and does not teach, suggest, or disclose the construction of such “media channels” using such user selected and scheduled media content. Instead, the cited portion of Ellis at col. 8, lines 51-61 simply describes an “interactive television program guide” that may be used to access schedule information. Therefore, Applicants respectfully submit that the cited portion of Ellis at col. 8, lines 51-61 does not teach, suggest, or disclose,

at least, Applicants' claim feature "...software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content...." Applicants now turn to the portion of Ellis at col. 10, line 34 to col. 11, line 25, beginning with the portion at col. 10, lines 34-44, which recites:

The program guide may allow the user to access information using various selectable options. An illustrative menu screen 156 that may be displayed by the program guide is shown in FIG. 11. Option 158 may provide the user with an opportunity to view television program schedule information for traditional television channels. Option 160 may launch a web browser or other suitable software that allows the user to browse the Internet. Personal channels option 162 may provide the user with an opportunity to view program schedule information for personal television channel programming.

The cited portion of Ellis shown above simply teaches that an "interactive television] program guide" may allow a user to access information for a number of "selectable options," including an "option 158" that allows a user to view traditional television program schedule information, an "option 160" that may launch a web browser for browsing the Internet, and an "option 162" that allows a user to view schedule information for "personal television channel programming." No mention is made of a user "constructing" anything, let alone one or more "media channels." This portion of Ellis is also silent with respect to the user selecting media content or scheduling media content for use in constructing such "media channels." Therefore, Applicants respectfully submit that the cited portion of Ellis at col. 10, lines 34-44 does not teach, suggest, or disclose, at least, Applicants' claim feature "...software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content...." Applicants now turn to the portion of Ellis at col. 10, lines 45-49, which recites:

An interactive advertisement 164 may be provided. If the user selects advertisement 164, the program guide may display information on the advertised product or may provide the user with options that allow the user to electronically order the advertised product.

The portion of Ellis shown above discloses that an “interactive advertisement” may be provided, and that user selection of the advertisement may display information or provide user options. Again, however, this portion of Ellis is silent with regard to a user “constructing” anything, let alone one or more “media channels.” This portion of Ellis is also silent with respect to the user selecting media content or scheduling media content for use in constructing such “media channels.” Therefore, Applicants respectfully submit that the cited portion of Ellis at col. 10, lines 45-49 also does not teach, suggest, or disclose, at least, Applicants’ claim feature “...software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content....” Applicants now review the portion of Ellis at col. 10, lines 50-60, which states:

If the user selects personal television channel showcase option 166, the program guide may display a screen such as personal channel showcase screen 168 of FIG. 12. Showcase screen 168 may contain information on the top 100 personal television channels. Ratings for the top 100 personal television channels may be obtained by monitoring which personal television channel programs are most often viewed. The monitoring process may involve logging requests to the servers on which the personal television programs are stored or may involve monitoring requests from the viewer's location.

In the portion shown above, Ellis discloses that the user may select an “option 166,” which may cause the “[interactive television] program guide” to display a screen such as “personal channel showcase screen 168” that may contain information on the “top 100 personal television channels.” This cited passage from Ellis further explains

that the ratings for the “top 100 personal television channels” may be determined by monitoring which “personal television channel programs” are most often viewed, and that “monitoring” may involve logging requests to servers or from viewer’s locations. Applicants respectfully submit, however, that this cited portion of Ellis fails to disclose a user “constructing” anything, let alone make any mention construction of one or more “media channels.” The cited portion of Ellis at col. 10, lines 50-60 also does not disclose a user selecting media content or scheduling media content for use in constructing such “media channels.” Applicants respectfully submit, therefore, that the portion of Ellis at col. 10, lines 50-60 does not teach, suggest, or disclose, at least, Applicants’ claim feature “...software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content...” Applicants now turn to the portion of Ellis at col. 10, line 61 to col. 11, line 6, shown below:

Personal television program information that is displayed on screen 168 and any other suitable display screens may contain star ratings 170 (indicating a critic's opinion of a program). Certain recommendations may also be made by the provider of screen 168 or by a critic. For example, a region of screen 168 such as our recommendations region 172 may be used to showcase recommended programming. Programming may also be grouped by category (e.g., all programming related to sports or to family issues, etc.) A user may scroll through the listings provided in such regions, as indicated by arrows 174. Reviews of certain personal television channel programming may be obtained by selecting reviews option 176.

This cited portion of Ellis explains that “personal television program information” displayed on a suitable “display screen” may contain “star ratings” that indicate a critic’s opinion of the program, and that a region of the “display screen” may be a “recommendations region” used to showcase recommended programming. Programming may be grouped in a “region” by category, a user may scroll through program listings provided in such “regions,” and a user may select a “reviews option” to

obtain reviews of “personal television channel programming.” Applicants respectfully submit, however, that this portion of Ellis again fails to disclose a user “constructing” anything, let alone constructing one or more “media channels.” The portion of Ellis at col. 10, line 61 to col. 11, line 6 also does not teach of a user selecting media content or scheduling media content for use in constructing such “media channels.” Applicants respectfully submit, therefore, that the cited portion of Ellis at col. 10, line 61 to col. 11, line 6 does not teach, suggest, or disclose, at least, Applicants’ claim feature “...software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content....” Applicants now address the disclosure of Ellis at cited col. 11, lines 7-13, reproduced below:

Selectable links may be associated with the listed personal television programs. For example, links 177 may be provided. When links 177 are selected, the program guide may launch a web browser and direct the user to an associated web site or may launch a chat application to provide the user with an opportunity to join a chat related to a particular program, etc.

Ellis explains in the passage shown above that selectable “links” may be associated with “personal television programs,” and that selection of such “links” may cause a web browser to be launched. The web browser may bring the user to a web site associated with the “personal television program.” Alternately, the selection of such “links” may launch a chat application so that the user can join a chat related to a program. Applicants respectfully note that selection is of “links” to web sites/web pages. Applicants respectfully submit that this portion of Ellis fails to make any mention of a user “constructing” anything, let alone constructing one or more “media channels.” The portion of Ellis at col. 11, lines 7-13 does not teach of a user selecting media content or scheduling media content for use in constructing such “media channels.” Applicants respectfully submit, therefore, that the cited portion of Ellis at col. 11, lines 7-13 does not teach, suggest, or disclose, at least, Applicants’ claim feature “...software resident in

a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content....” Applicants now review the remaining portion of the disclosure of Ellis at col. 11, lines 14-25, which recites:

If the user selects personal channels option 162 of FIG. 11, the program guide may display a screen of program listings that are all for personal television channel programs, as shown in FIG. 13. Screen 178 of FIG. 13 may include call letter or station identification information 180. Personal television channel description information 182 that describes each personal television channel may also be included. In addition, screen 178 may contain information 184 on the title of the current program on each channel and description information 186 for each of these programs. Arrows 188 indicate that the user may scroll to view other channels of interest.

The passage from Ellis reproduced above discloses that by selecting an “option 162,” a user may be shown a screen listing all “personal television programs,” including information such as “call letter” or “station identification” information, information describing each “personal television channel” along with the title of the current program on each “personal television channel” and “description information” for each program. Ellis also teaches that a user may scroll to view other channels of interest. Applicants respectfully submit, however, that the cited passage of Ellis shown above once again fails to make any mention of a user “constructing” anything, let alone constructing one or more “media channels.” This passage from Ellis, specifically selected by the Office, also does not teach of a user selecting media content or scheduling media content for use in constructing such “media channels.” Therefore, Applicants respectfully submit that Ellis at col. 11, lines 14-25 also does not teach, suggest, or disclose, at least, Applicants’ claim feature “...software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to

construct, at the first home, the one or more media channels from user selected and scheduled media content....”

Applicants have now reviewed all portions of Ellis selected by the Office as disclosing Applicants’ claim feature “...software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content...,” and have demonstrated that, contrary to the assertions of the Office, Ellis does not teach, suggest, or disclose at least this aspect of Applicants’ claim 1.

Applicants respectfully submit that Applicants have now demonstrated that the purportedly most relevant portions of Ellis do not teach at least this aspect of Applicants’ claim 1. Applicants again respectfully note that the Office cited only Ellis, and did not assert that Schoen and/or Parker provided any support for a rejection of this aspect of claim 1. Further, the Office has not asserted that Schoen and/or Parker have any teachings in this regard. Applicants respectfully note that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” Applicants respectfully submit, therefore, that it necessarily follows that the Office has failed to show how and why the proposed combination of Ellis, Schoen, and Parker teaches, suggests, or discloses all aspects of Applicants’ claim 1, that the teachings of the cited art are not sufficient to support a *prima facie* case of obviousness with respect to claim 1, as required by M.P.E.P. §2142, and that claim 1 and its dependent claims are allowable over the cited art for at least the reasons set forth above. Applicants respectfully submit that claim 1 is allowable for at least an additional reason.

Applicants’ claim 1 also recites, in part, ...“the software also enabling closed and secure communication of the one or more media channels to members of a user group, in a peer to peer manner, from the first home to the second home.” Applicants respectfully submit that the Office action states, in part, at pages 5-6, that “Ellis is

unclear with respect to **"the software also enabling closed and secure communication of the one or more media channels to members of a user group, in a peer to peer manner, from the first home to the second home";....**" (emphasis in original) Applicants respectfully submit that Ellis is more than "unclear," Ellis simply does not teach, suggest, or disclose at least this aspect of Applicants' claim 1. However, the Office then mistakenly relies upon Schoen stating, in part, at page 6:

Schoen teaches the local instant messaging secure public key infrastructure proxies 22a and 22b are preferably implemented as software applications that are executed by one or more processing devices in the instant messaging device as the **software enabling closed and secure communication** (i.e. Virtual private networks (VPN) are known which use a public key infrastructure (PKI) to identify participants in the VPN to establish secure communications) **(Schoen, col. 2 lines 30-38) of the one or more media channels to members of a user group** (i.e. the instant message exchanged in a buddy lists. The secure instant messaging group policy certificate defines a plurality of different instant messaging groups, each identified by an instant messaging group identifier) **(Schoen, col. 4 lines 8-21), in a peer to peer manner, from the first home to the second home;** (Fig. 1 of Schoen illustrates the instant messaging system 10 includes an instant messaging server 12. The instant messaging server 12 is in operative communication with a plurality of instant messaging devices as PDA, Set-top box, computers etc... **in a peer to peer manner**. For purposes of discussion, one of the instant messaging devices will be referred to as an instant messaging originator 14 which will be described as initiating an instant message while another instant messaging device 16 will be referred to as instant message recipient, although it will be recognized that either device may operate to send or received instant messages) **(Schoen, col. 6 lines 1-65).**

Applicants respectfully disagree with what Schoen allegedly discloses. Applicants respectfully submit that the term "peer to peer" is not present anywhere in the cited portions of Schoen, or anywhere else in the text or figures of Schoen. In support for its assertion that Schoen teaches this aspect of Applicants' claim 1, the

Office recites language from Schoen, but fails to provide any explanation of how and why the text copied from Schoen, which does not mention the phrase “peer to peer” teaches “peer to peer” communication, as claimed. Instead, the Office merely repeats language from Applicants’ claim 1, inserts pieces of text from the cited portion of Schoen, and adds a citation to a portion of Schoen. Applicants respectfully submit that Schoen does not disclose “peer to peer,” as claimed, that the Office has failed to provide the “explicit analysis” required by M.P.E.P. §2142 to show how and why the cited portions of Schoen teach what is asserted, that the Office has not established the required support for a *prima facie* case of obviousness with respect to at least this aspect of Applicants’ claim 1, and that claim 1 is allowable for at least this reason.

Further, the Office does not assert that Parker provides any teachings of “peer to peer” communication (the Office admitted that Ellis doesn’t teach this aspect of claim 1). Thus, because Ellis admittedly does not teach this aspect of Applicants’ claim 1, and Applicants have shown that Schoen does not teach this aspect of Applicants’ claim 1, and the Office does not even assert that Parker teaches this aspect of claim 1, Applicants respectfully submit that the proposed combination of references cannot teach at least this aspect of Applicants’ claim 1, that claim 1 is not rendered unpatentable, and that claim 1 is allowable over the cited art for at least this additional reason.

With regard to independent claim 14, Applicants respectfully submit that the Office action rejects claim 14 at page 11, stating “[r]egarding claim 14: recites the features similar to those of claim 1. Therefore, claim 14 is rejected for the same reason as discussed in claim 1.” Applicants have demonstrated that claim 1 is allowable over the cited art. Therefore, because claim 14 is rejected “for the same reason” and the same art relied upon in the rejection of claim 1, Applicants respectfully submit that claim 14 and its dependent claims are also allowable over the proposed combination of Ellis, Schoen, and Parker for at least the same reasons set forth with respect to claim 1.

With regard to independent claim 25, Applicants respectfully submit that the Office action rejects claim 25 at page 12, stating “[r]egarding claim 25: recites the

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features similar to those of claim 1. Therefore, claim 25 is rejected for the same reason as discussed in claim 1.” Applicants have demonstrated that claim 1 is allowable over the cited art. Therefore, because claim 25 is rejected “for the same reason” and the same art relied upon in the rejection of claim 1, Applicants respectfully submit that claim 25 and its dependent claims are also allowable over the proposed combination of Ellis, Schoen, and Parker for at least the same reasons set forth with respect to claim 1.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that independent claims 1, 14, and 25 and their respective dependent claims are allowable over the proposed combination of Ellis, Schoen, and Parker, and respectfully request that the rejection of claims 1-7, 9-19, 21-31, and 33-40 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

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Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully solicit a call to the undersigned at (312) 775-8000 to resolve any issues, should the Commissioner or staff have any questions regarding this submission.

The Commissioner is hereby authorized to charge any fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, Suite 3400
Chicago, Illinois 60661
Phone (312) 775-8000
Facsimile (312) 775-8100

/Kevin E. Borg/
Kevin E. Borg
Agent for Applicants
Reg. No. 51,486